



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,436	09/29/2005	Jens Storkel	02894-0711US1/06651-PT22	6040

26161 7590 02/28/2011
FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

CHIN, RANDALL E

ART UNIT	PAPER NUMBER
----------	--------------

3723

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

02/28/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/535,436	Applicant(s) STORKEL ET AL.	
	Examiner Randall Chin	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-9 and 11-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9 and 11-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, lines 2-4, it is unclear whether the “alphanumeric character or symbol” is actually formed by the “plastic of the encapsulating layer”. In other words, how does the recess define an alphanumeric character or symbol? There should be clear connection between the elements of the claim for clarity of scope. Also, in claim 26, line 2, what is “its surface” referring to?

Claim Objections

3. Claim 15 is objected to because of the following informalities:

Claim 15, “the convex rounding” lacks proper antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 5-9, 11-17, 19-27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishihira et al. 4,330,578 (hereinafter Nishihira).

As for claim 1, the patent to Nishihira discloses in Figs. 1 and 2 an injection molded part 1 (col. 1, lines 7-9 and 36-50) comprising a body 11 injection-molded from a first plastic (col. 2, lines 20-21), wherein the body comprises a transparent and/or opaque and/or translucent plastic (col. 2, lines 31-42), a printed ink layer of desired pattern or decoration 3 (col. 2, lines 43-45) having a decorative first side and a back side is applied on a surface of the body 11 (Figs. 1b and 1e), with the decorative first side of the decoration applied to the surface of the body 11 such that the decorative first side is visible through the body 11 (since body 11 can be transparent as recited above), and an injection-molded encapsulation 12 of a second plastic covering the decoration 3 (Fig. 1e; col. 3, lines 14-17). It should be noted that claim 1 does not require that “a first plastic” be different from “a second plastic”.

As for claim 3, the encapsulation 12 covers one or more decoration-free regions of the body 11 with the first and second plastics bonded to each other (Figs. 1b and 1e; col. 1, line 62 to col. 2, line 2).

As for claim 5 reciting that the first and second plastics have different degrees of hardness, Nishihira teaches use of a variety of different materials or resins and also implies that the first and second plastics could well be **different** from one another (col. 2, lines 31-37 and col. 3, lines 17-26) thus inherently providing different degrees of hardness, at least even to a slight degree.

As for claim 6, the decoration-free regions are arranged in an edge region adjacent the decoration 3 (Figs. 1b and 1e).

As for claim 7, the encapsulation 12 extends over the body 11 “beyond the edge region” (a broad phrase) adjacent the decoration 3 (Fig. 1e).

As for claim 8, the decoration-free regions are arranged in an interior region of the decoration 3 (Fig. 1e).

As for claim 9, the body 11 has, in one or more of the decoration-free regions or “recesses” (i.e., to the extent that these “recesses” are shown in Figs. 1-3 of the instant application) which are open toward its surface and are filled by the second plastic of the encapsulation 12 (Fig. 1e). Applicant is cautioned with the entry of nay new matter.

As for claim 11, the surface of the body 11 bearing the decoration 3 is substantially planar (Figs. 1b and 1e).

As for claim 12, the surface of the body 11 bearing the decoration 3 is convexly curved, at least at the **corners** (Fig. 1e).

As for claim 13, “an edge region” (a broad recitation) which can be **any side** portion/wall of the surface of the body 11 surrounding the decoration 3 is formed at a lower-lying level than the surface covered by the decoration 3 (Figs. 1b or 1e).

As for claim 14, the edge region of the surface of the body 11 "surrounding" (a broad term) the decoration 3 is formed in a convexly rounded manner, at least at the **corners** (Fig. 1e).

As for claim 15, the convex rounding extends into an outer edge region of the surface of the body 11 bearing the decoration 3 (Fig. 1e).

As for claims 16 and 17 reciting that the decoration is applied by means of a hot transfer film, by means of a metallized film, or by printing, methods of forming are not germane to patentability in apparatus claims. In any case, in Nishihira, the decoration is applied by printing (col. 2, lines 44-50).

As for claims 19 and 30 reciting that the part is a toothbrush body, no inference or assumption will be made that the "part" includes for example, bristles or a "cleaning" element(s). In any case, Nishihira's part 1 can be considered a toothbrush body.

As for claim 30, the encapsulation 12 covers one or more decoration-free regions of the toothbrush body with the first and second plastics 11, 12, respectively, bonded to each other (Fig. 1e; col. 1, line 62 to col. 2, line 2).

As for claim 20, Nishihira teaches in Fig. 1 (see also explanation provided for claim 1 above) a method of injection molding a part 1 (col. 1, line 51 to col. 3, line 5), the method comprising injection molding a body 11 from a first plastic, the body comprising a transparent or translucent plastic, applying at least a two-dimensional decoration 3 to a surface of the body 11, the decoration 3 having a decorative front side and a back side, the decoration 3 applied with its decorative front side facing the body 11, such that the decorative front side is visible through the body 11, and then covering the applied

Art Unit: 3723

decoration with an encapsulating layer 12 of a second plastic, the second plastic injection molded over the decoration 3. It should be noted that claim 20 does not require that “a first plastic” be different from “a second plastic”.

As for claim 21, the encapsulating layer 12 covers a decoration-free region of the body and the first plastic bonds with the second plastic in the decoration-free region (Fig. 1e).

As for claim 22 reciting that the first and second plastics have different degrees of hardness, Nishihira teaches use of a variety of different materials or resins and also implies that the first and second plastics could well be **different** from one another (col. 2, lines 31-37 and col. 3, lines 17-26) thus inherently providing different degrees of hardness, at least even to a slight degree.

As for claim 23, the decoration-free region is an edge region adjacent the decoration 3 (Fig. 1e).

As for claim 24, the encapsulating layer 12 extends over the body 11 “beyond the edge region” (a broad phrase; Fig. 1e).

As for claim 25, the decoration-free region is arranged in an interior region defined within the decoration 3 (Fig. 1e).

As well as claim 26 is understood, the body 11 has a “recess” (i.e., to the extent that this “recess” is shown in Figs. 1-3 of the instant application) in the decoration-free region which are open toward its surface and are filled by the plastic of the encapsulating layer 12, the recess defining a print pattern (col. 2, lines 44-66) which would at least be a symbol (Fig. 1e).

As for claim 27, "an edge region" (a broad recitation) which can be **any side** portion/wall of the surface of the body 11 surrounding the decoration 3 is formed at a lower-lying level than a covered region of the surface under the decoration 3 (Figs. 1b or 1e).

As for claim 29 reciting that the part is a toothbrush body, no inference or assumption will be made that the "part" includes for example, bristles or a "cleaning" element(s). In any case, Nishihira's part 1 can be considered a toothbrush body.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishihira.

As for claim 18 reciting that there is a further decoration applied to the encapsulation, and a further encapsulation, which covers one or more regions of the first encapsulation that are free from the further decoration with the second encapsulation bonded to the first encapsulation, it is the position of the Examiner that such a modification would involve a mere duplication of parts and would be well within the level of ordinary skill to provide for *any* number of "layers" of encapsulation and

Art Unit: 3723

decoration, as desired, for either aesthetic and/or advertising/marketing of logos/indicia, for example.

Method claim 28 is rejected along the same line of reasoning as claim 18 above.

8. Applicant's arguments with respect to claims 1, 3, 5-9 and 11-30 have been considered but are moot in view of the new ground(s) of rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3723

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randall Chin/
Primary Examiner, Art Unit 3723